



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,639	11/17/2003	Bruce W. Anderson	GP106-09.DV2	4320

21365 7590 12/21/2006
GEN PROBE INCORPORATED
10210 GENETIC CENTER DRIVE
SAN DIEGO, CA 92121

EXAMINER

NAGPAUL, JYOTI

ART UNIT	PAPER NUMBER
----------	--------------

1743

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/715,639

Applicant(s)

ANDERSON ET AL.

Examiner

Jyoti Nagpaul

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Amendment filed on November 17, 2006 has been acknowledged. Claims 26-55 are pending.

Response to Amendment

Upon further consideration, Examiner is withdrawing finality and a new rejection has been applied. See below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 26-27 and 35-36** are rejected under 35 U.S.C. 102(b) as being anticipated by Kath (US 5945070).

Kath teaches a fluid-holding vessel (1) comprising an open end, a closed end and a side wall/bottom of the vessel having an inner surface and a specimen retrieval device comprising a swab (6) having a handle member (7), the specimen retrieval device contained within the vessel (1). Kath further teaches a peirceable cap (12 and 13) fixed to the open end of the vessel (1), wherein the cap positions the specimen retrieval device along the inner surface of the vessel, such that the specimen retrieval device does not significantly interfere with the movement of a fluid transfer device (15) into or out of the collection device. The handle member (7) includes a score line (the joint between member (3) and member (7)) to facilitate removing a portion of the handle

Art Unit: 1743

prior to fixing the cap onto the open end of the vessel (1). Kath does not explicitly teach that the cap can be pierced by the pipette tip with the application of less than 8 pounds force. It is inherent that the cap is pierced by the pipette tip (15) with some amount of force that is less than 8 pounds force. The cap (12 and 13) and the vessel (1) include mated threads and the cap is screwed onto the open end of the vessel (1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. **Claims 33 and 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kath in view of Shillington (US 4600112).

Refer above for the teachings of Kath.

Kath fails to teach wherein the cap has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations.

Shillington teaches a pass-through closure. The cap (10) has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations.

(See Figure 3)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kath such that the cap has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations in order to inhibit the insertion and withdrawal of a hand to retrieve an article from the vessel.

7. **Claims 28-32, 37-42, 45-51 and 54-55** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kath (US 5945070) in view of Percarpio (US 4301936).

Refer above for the teachings of Kath.

Kath fails to teach the fluid transfer device is a plastic pipette tip and wherein the cap and the vessel are each formed from a plastic resin. Kath fails to teach the cap further comprises a wick for inhibiting the release of an aerosol or bubbles from the collection device wherein the wick is a pile fabric. Kath further fails to teach the cap includes a seal for retaining the wick within the cap.

Percarpio teaches a closure assembly for a vessel. The cap comprises a wick (56) for inhibiting the release of an aerosol or bubbles from the collection device wherein the wick is a pile fabric/foam. Percarpio further teaches a seal (10) for retaining the wick (56) within the cap (50). (See Col. 8, Lines 55-63)

It is conventionally known that it would be advantageous to use plastic because it is inexpensive, inert, lightweight and readily available. (See In re Leshin)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kath such that the fluid transfer device is a plastic pipette tip and the cap and vessel are each formed from a plastic resin in order to gain the above advantages and the selection of a known material based on its suitability for its intended use is obvious. (See In re Leshin)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kath such that the cap comprises a wick a wick for inhibiting the release of an aerosol or bubbles from the collection device wherein the wick is a pile fabric and a seal for retaining the wick within the cap in order to halting the flow of material through the needle and further more requires less force to penetrate with a needle.

8. **Claims 43-44 and 52-53** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kath (US 5945070) in view of Percarpio (US 4301936) as applied to claims 37 and 47 above, and further in view of Shillington.

Refer above for the teachings of Kath and Percarpio.

Kath and Percarpio fail to teach the cap has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations.

Art Unit: 1743

Shillington teaches a pass-through closure. The cap (10) has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations.

(See Figure 3)

It would have been obvious to a person of ordinary skill in the art to modify the device of Kath in view of Percarpio such that the cap has a generally conical inner wall wherein the inner wall includes a plurality of radially extending striations as suggested by Shillington in order to inhibit the insertion and withdrawal of a hand to retrieve an article from the vessel.

Response to Arguments

9. Applicant's arguments with respect to claims 26-55 have been considered but are moot in view of the new ground(s) of rejection. See the above rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Nagpaul whose telephone number is 571-272-1273. The examiner can normally be reached on Monday thru Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JN


Jill Warden
Supervisory Patent Examiner
Technology Center 1700